Appl. No. 10/696,148
Req. for Recon: Jan. 14, 2008

REMARKS

The March 7, 2007 Action rejected all claims pending in the application under §102 and stated that the 1.131 Declaration filed on February 9, 2007 was insufficient to establish diligence and a conception of the invention. Applicant responded on June 5, 2007 and submitted a second 1.131 Declaration. A Fifth Action was issued on September 19, 2007 which again rejected all claims pending and stated that the Declarations of record were insufficient to establish diligence and conception of the invention. Applicant's Attorney discussed the Declarations via teleconference with the Examiner and on December 19, 2007, the Examiner left Applicant's Attorney a voice message to submit this Request for Reconsideration in view of the previous discussions. The present Response submits arguments in favor of accepting the Declaration and withdrawing the §102 rejections.

Declarations under 37 CFR 1.131

The following are reiterated from Applicant's response dated June 5, 2007.

A Declaration of Eng-Keong Lee, the sole inventor of the subject matter described and claimed in U.S. Patent Application Serial No. 10/696,148, was submitted on February 9, 2007. Three exhibits accompanied the Declaration along with detailed explanations of what each exhibit represents. Below is a summation of what each exhibit contains.

Exhibit A was an excerpt of an *internal project management* document dated August 26, 2002. The document is a functional specification of the "Talon" project which was released as Unified Communicator® v.2.0 in mid 2003. The Talon project discusses "alerts" and "tray client enhancements" which embody Mr. Lee's invention. It should be realized that Talon or U.C. v2.0 included many additional features, not just the inventive subject matter of Mr. Lee.

Exhibit B was an excerpt of another *internal project management* document dated October 1, 2002 (rev 4) and October 25, 2002 (rev 5). This document further defines the functional specification of the Talon project and demonstrates that the Inventor and assignee were continuing to work and improve on the project in preparation for release.

Appl. No. 10/696,148
Req. for Recon: Jan. 14, 2008

Exhibit C was an excerpt of the Unified Communicator v.2.0 Installation and Configuration Manual dated August 2003. The Manual accompanied the _sale of the Unified Communicator v.2.0 product_. As with the previous exhibits, this document discusses the "alerts" and "tray client enhancements" which embody Mr. Lee's invention.

On October 29, 2003, Applicant filed a patent application claiming the inventive subject matter included in the Talon project, namely the "status notification systems" invented by Mr. Lee. The product was generally available for sale late July 2003.

Detailed Action paragraph 2.

The Action states that the Declaration filed under 37 CFR 1.131 is insufficient to establish diligence from a date prior to the date of reduction to practice of the Appelman et al. reference (U.S. Application Publication. No. 2004/0196963) to either a constructive or actual reduction to practice of Applicant's invention. The Examiner faults the Applicant for not providing sufficient evidence to explain why Applicant's patent application was filed more than one year after the submitted Exhibits' dated August 29, 2002 and October 1, 2002. It is believed that the Examiner has misunderstood the Declaration and the Exhibits filed.

Pursuant to MPEP 715.07(a) and 37 CFR 1.131, the critical period in which diligence must be shown **begins just prior to the effective date of the cited reference and ends with the date of Applicant's reduction to practice.** The Appelman reference was filed December 30, 2003 and claims priority under 35 U.S.C. §119(e) to provisional application no. 60/459,273 filed on April 2, 2003. Assuming the effective date of Appelman is April 2, 2003, Applicant must show diligence from just prior to April 2, 2003 to late July 2003, when Applicant's product was generally available. Any lapse of time between reduction to practice and the filing of an application thereon is not relevant to the declaration under 37 CFR 1.131 (MPEP 715.07a).

Applicant notes that the Examiner is requesting a showing of diligence for a period of less than 4 months. As those skilled in the telecommunications industry can attest, engineering projects often take several months and even years to complete.

Appl. No. 10/696,148
Req. for Recon: Jan. 14, 2008

Four months is certainly not a questionable amount of time for this level of engineering project. Nonetheless, Applicant submits herewith a second Declaration of Mr. Lee under 37 CFR 1.131 to establish additional diligence for the time in question. Namely, a project timeline dated June 10, 2003 shows the Talon project began Alpha testing on March 24, 2003 and Beta testing on May 19, 2003. As previously evidenced, the Talon project included the inventive subject matter of the present patent application. A second document dated May 16, 2003 is a copy of the Beta Solicitation Package presented to third parties requesting participation in the U.C. v2.0 beta program. A third document dated July 30, 2003 announces the completion of Beta testing and a confirmation that the product is to be released late July 2003. A fourth document dated July 31, 2003 is a news release announcing the general availability of Unified Communicator v2.0.

Detailed Action paragraph 3.

The Action states that the Declaration filed under 37 CFR 1.131 is insufficient to establish a conception of the invention prior to the effective date of the Appelman et al. reference (U.S. Application Publication. No. 2004/0196963). Specifically, the Examiner faults the Applicant for not providing (i) support in the Exhibits for the claim limitation "unbeknownst to the contact" and (ii) proof that the Exhibits are associated with the inventor, Mr. Lee.

MPEP 716.02(g) states "[T]he reason for requiring evidence in declaration or affidavit form is to obtain the assurances that any statements or representations made are correct as provided by 35 U.S.C. 25 and 18 U.S.C. 1001." Paragraph 4 of the Declaration signed by Mr. Lee on February 8, 2007 states that the "*Exhibits resulted from my research, programming, and engineering to create an alert system to notify the user when a reportable event has occurred.*" Mr. Lee declared that of his own knowledge, all the statements made in the Declaration are believed to be true. Due to the nature of the Exhibits, Mr. Lee's name does not appear on the Exhibits. For example, Exhibit C is an installation and configuration manual that was released with the product. Simply because Inter-Tel, the assignee/owner of the subject patent application and Mr. Lee's employer, chose not to list all of the individual contributors,

Appl. No. 10/696,148
Req. for Recon: Jan. 1‡, 2008

engineers, inventors and the like that created the product, doesn't mean that those individuals were not associated with the project. Mr. Lee's signature on the Declaration should meet any burden of proof required by the USPTO that the Exhibits include Mr. Lee's inventive subject matter.

Appl. No. 10/696,148
Req. for Recon: Jan. 14, 2008

Claim Rejections –35 USC§102

All claims, 1, 2, 4-9 and 11-18, stand rejected under 35 U.S.C. §102 as being anticipated by U.S. Application Publication. No. 2004/0196963 to Appelman et al. and U.S. Patent No. 6,553,341 to Mullaly et al. For the following reasons Applicant respectfully traverses these rejections.

Appleman et al.

The Appelman Patent Application was filed on December 30, 2003 and claims priority under 35 U.S.C. §119(e) to Appelman Provisional Application No. 60/459,273 filed on April 2, 2003. Applicant's application under examination was filed on October 29, 2003, prior to the Appelman Patent Application filing date but after the Provisional filing dates.

In Applicant's prior responses, Applicant has argued that the Appelman Patent Application includes additional subject matter that was not included in the Appelman Provisional Application and therefore is not supported by the earlier filing date of the Provisional. Additionally, Applicant has argued that the Appleman Patent Application fails to disclose each and every element of Applicant's invention as claimed.

In the desire of swift prosecution of Applicant's patent application, on February 9, 2007 Applicant submitted a Declaration under 37 CFR §1.131 with accompanying documents to establish a priority of invention in this application at a date prior to April 2, 2003, the effective filing date of the Appleman Provisional Application. The March 7, 2007 Action stated the Declaration was ineffective to overcome the Appleman reference. Applicant responded to the Examiner's concerns regarding the Declaration in the preceding paragraphs and submits a second Declaration and documents to fulfill the Examiner's request for diligence. Applicant respectfully submits that the Declarations overcome the Section 102(e) rejection by way of swearing behind the Appleman reference.

Appl. No. 10/696,148
Req. for Recon: Jan. 14, 2008

Mullaly et al.

All claims stand rejected under 35 U.S.C. §102(a) as being anticipated by U.S. Patent 6,553,341 to Mullaly et al. For the reasons stated herein, Applicant respectfully traverses.

In general, Mullaly discloses a system for announcing the receipt of an electronic message, such as by synthesized speech (Abstract). The Background states that because of the large amounts of email sent between users, often times a user will check his mailbox and find a multitude of new email that has arrived since the last time the user checked his box. This situation can result in important messages being ignored or unseen. *It is desirable for an arrival of the new email with the desired information to be announced in an audible fashion.* (Column 2, lines 15-26) An audible notification using text to speech technology announces various details of the email message. For instance, a user may select or customize announcements using natural language sentences, phrases, or anything that the user may desire. (Column 6, lines 4-6) A user may specify multiple types of announcements with identifying data that is to be parsed from email messages, such as, for example, the sender of the message and/or the subject of the message. For example, an announcement to the user may be, "Excuse me, Steve Daniel's has just sent you mail about the plant trip", where "Steve Daniel's" and "plant trip" are parsed and extracted from a note from Steve Daniel's and combined with surrounding text to form an appropriate and informative announcement. (Column 7, lines 49-60) In this manner, the announcement audibly informs the user of the content of the message so the user does not miss an important message, and the user is better informed about the information received without having to shift from their current task. (Column 11 line 61 to column 12 line 5).

After messages are filtered and processed, they are listed in a GUI (such as GUI 600). Referring to Figure 6, GUI 600 illustrates a listing of messages received by the user over a specified period of time. The user may select one of the entries to display the entire message and may send mail by selecting mail button 626.

Applicant discloses and claims a "*viewable call-control option*" that is received "*simultaneously with the alert*." As specifically set forth in Applicant's specification, "*a*

Appl. No. 10/696,148
Req. for Recon: Jan. 14, 2008

call control option" is provided to the user so that the user can immediately respond to the message alert with a telecommunication function related to the event. For example, Figures 5A and 5B from Applicant's specification are shown below. The exemplary pop-up alert 5A displays the *informational status message pertaining to the contact* ("Sheila Brown's status has changed to available") and includes a *viewable call control option delivered simultaneous with the message alert* ("call"). When activated by the user, the hotspot "call" immediately places a call from the user to Sheila Brown's extension or number. The exemplary pop-up alert 5B may appear immediately after the user selects the call control option. Now the user is provided with a different informational status message ("Calling Sheila Brown at 21352) and includes different call control options pertinent to the current alert ("Hangup", "Leave Message", "Send to Voicemail"). Again, the user has the option to select one of the call control options to cause the telecommunication function to occur.
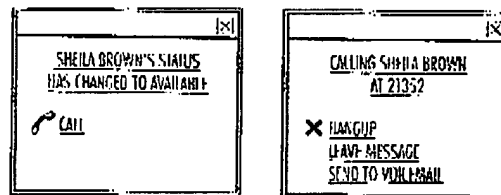

Fig. 5A   Fig. 5B

Mullaly fails to disclose *a viewable call-control option* received *simultaneous with the alert*. The Examiner points to Mullaly column 2, lines 36–43 for support of "an instant message alert" as claimed by Applicant. Referring to the selected Mullaly passage, when a message including test is received, the message is filtered to determined what will be announced. Text from the filtered message is selectively combined with announcement text to create modified announcement text in which filtered text is selectively placed into the announcement text. The modified announcement text is then transformed into synthesized speech or combined synthesized speech with prerecorded audio. As can be seen from the above passage, the Mullaly "alert" is an audible announcement of the receipt of an email message and the message text is filtered and transformed into speech. There is no "*viewable* call-control option" received simultaneous with the audible alert.

Page 8 of 10

Appl. No. 10/696,148
Req. for Recon: Jan. 11, 2008

Mullaly is a email messaging alert system and fails to disclose any *call-control* *options*. The only option available to the Mullaly user is to "send mail" such as from GUI 600 and the "send mail" button 626. "Sending mail" is referring to sending an email message to a contact and this *not similar* to selecting a "call-control option" as disclosed and claimed by Applicant. Additionally, for the user to actually "send mail" from the GUI, the user must first select one of the entries from the compiled list of received messages, view the particular message and then select "send mail". This operation is not akin to Applicant's status notification system whereby *a message alert* *is received (e.g., Fig. 5A) comprising a viewable informational status message* *pertaining to the contract and a viewable call-control option received simultaneous with* *the message alert*. Furthermore, the *"send mail"* option *is not* available simultaneous with the Mullaly message alert.

Applicant respectfully submits that Mullaly fails to teach each and every element of Applicant's claims. Accordingly, Applicant requests that the Examiner withdraw the §102 rejections to all claims pending.

Appl. No. 10/696,148
Req. for Recon: Jan. 14, 2008

CONCLUSION

Applicant respectfully requests withdrawal of the §102 rejections and issuance of a timely Notice of Allowance.   Should the Examiner wish to discuss any of the above in greater detail then the Examiner is invited to contact the undersigned at the Examiner's convenience.

Respectfully submitted,
Inter-Tel (Delaware), Inc.

Date: _____

By: _____
Michelle R. Whittington, Esq.
Intellectual Property Counsel
Inter-Tel (Delaware), Inc.
Reg. No. 43,844

INTER-TEL (DELAWARE), INC.
7300 W. Boston St.
Chandler, AZ 85226
Direct: (480) 961-9000 x21352
Facsimile:(480) 961-8073
Email: michelle_whittington@inter-tel.com